

### REMARKS

Initially, Applicants thank the Examiner for the courtesies extended in the personal interview held on April 2, 2003. In accordance with the interview, claims 1 and 21 have been amended as follows:

Claims 1 and 21 have been amended to recite that an enriched environmental pool of organisms is formed in step a). Support for this is found in the specification and claims as originally filed.

Claims 1 and 21 have also been amended to recite that "between step a) and step b) there is no step of isolating organisms having the activity of interest from the enriched environmental pool of organisms." Support for this amendment is found in the specification and claims as originally filed, including, in the specification at page 4, which states that "the sample as such [i.e., the environmental sample discussed on page 3] is cultivated without any need for further purification." The term "isolation," as in "the isolation of an organism having an activity of interest," is synonymous with the terms "separation" or "purification." See, e.g., the definition of "isolation" in Hawley's Condensed Chemical Dictionary, 12<sup>th</sup> ed. (1993) (attached as Exhibit A). Support for this amendment is also found in the Examples, exemplifying the preparation of a gene library directly from an enriched environmental pool of organisms, i.e., without isolation of organisms having a particular activity of interest. Support for the amendment is also found in original claim 1, disclosing the preparation of a gene library from the resulting enriched pool of organisms.

An RCE application and responding to the last Office action were submitted on April 4, 2003.

In Office action sent on April 8, 2003, providing an Interview Summary, it is stated that:

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Applicants hereby concur with the Examiner's statement of the summary of the interview, namely, that proposed claim language was discussed, including language which would further clarify the invention and obviate the rejections of record. Applicants also agreed to point out where support for such amendments is found in the specification. The Examiner pointed out that

the proposed amendments would necessitate a new search, and therefore, Applicants submitted the amendment in the form of an RCE application instead of an Amendment under 37 CFR 1.116.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

**I. The Rejection of Claims 1-19, 21-25 and 27 under 35 U.S.C. 112**

Claims 1-19, 21-25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

First, the Examiner states that there is insufficient antecedent basis for the limitation "said enriched pool of organisms." Second, the Examiner states that it is unclear as to whether "the organisms" refer back to the organisms in the "enriched pool" or the organisms in the "environmental pool." Third, the Examiner states that it is unclear how the recitation "without screening the organisms for presence of the activity of interest" further limits the claims since a "screening" effect is obtained by cultivating the environmental pool under the enrichment conditions.

The claims have been amended to address these indefiniteness issues. In particular, claims 1 and 21 now recite "wherein between step a) and step b) there is no step of isolating organisms having the activity of interest from the enriched environmental pool of organisms." By this amendment, the claims now clarify that the organisms at issue are the "enriched pool" of organisms, and the claims now further limit the invention by specifying that there is not a step between steps a and b of "isolating" organism having a desired activity of interest from the enriched environmental pool of organisms.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

**II. The Rejection of the Claims under 35 U.S.C. 103(a)**

In paragraphs 4-7 of the Office action, all of the claims are rejected under 35 U.S.C. 103(a) over Duvick et al. (WO 96/06175) in combination with various secondary references.

Applicants respectfully submit that the claims, as amended, overcome the obviousness rejections. As amended, the claims now recite that "wherein between step a) and step b) there is no step of isolating organisms having the activity of interest from the enriched environmental pool of organisms." Duvick et al. does not teach or suggest the production of a gene library

without first isolating organisms having the activity of interest. See Duvick et al. at page 18, lines 1-3 (disclosing that after the organisms have been screened for their ability to degrade fumonisin, they are isolated; a gene library is then prepared using such isolated organisms).


Applicants submit that the claims overcome the rejections under 35 U.S.C. 103(a). Applicants respectfully request reconsideration and withdrawal of the rejection.

### III. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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